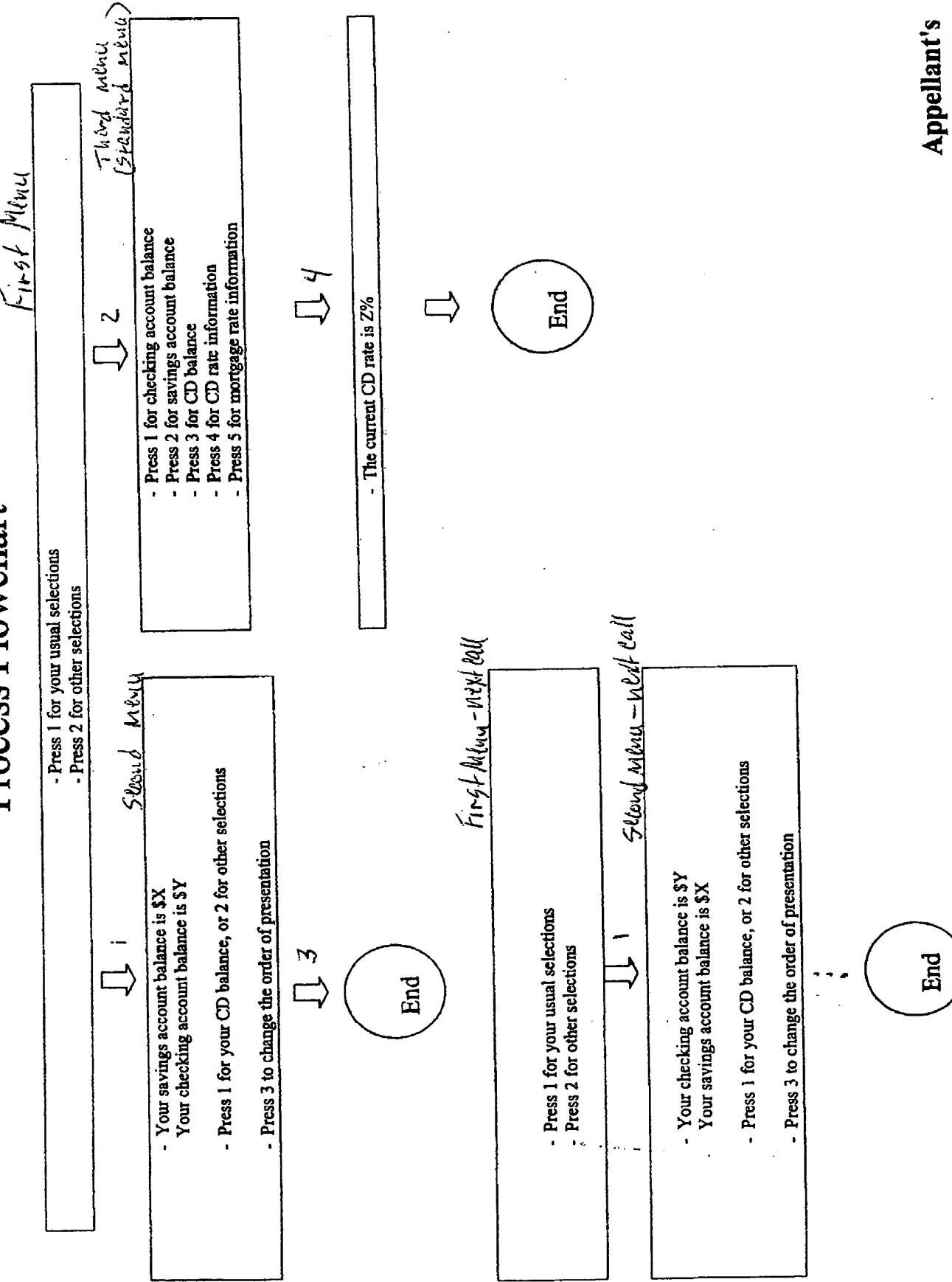


Polcyn et al. (U. S. Pat. No. 6,061,433)

Process Flowchart



Appellant's
Exhibit 1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Gee-Gwo Mei et al.

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Serial No.: 09/421,363 Group Art Unit: 2645

Filed: November 19, 1999 Examiner: Olisa Anwah

For: SYSTEM AND METHOD FOR PERSONALIZING DIALOGUE MENU FOR AN
INTERACTIVE VOICE RESPONSE SYSTEMHonorable Commissioner of Patents
Alexandria, VA 22313-1450

PETITION UNDER 37 C. F. R. §1.181 FOR WITHDRAWAL OF
NOTICE OF DEFECTIVE APPEAL BRIEF, ENTRY OF
AFTER-FINAL AMENDMENT, AND FOR AN EXAMINER'S ANSWER

Sir:

Comes now the Appellant and for this Petition states as follows:

1. That on January 28, 2005, Appellant filed an After-Final Amendment in response to an Office Action dated November 16, 2004, but in an Advisory Action dated February 5, 2005, the Examiner indicated that he refused to enter the Amendment on the grounds that the claim amendments allegedly "raise new issues";
2. That, contrary to the Examiner's assertions in the Advisory Action dated February 5, 2005, the January 28th Amendment did not raise new issues and did not require further search by the Examiner, and therefore, should have been entered by the Examiner;
3. That a Second After-Final Amendment under 37 CFR 1.116 (substantially the same as the Amendment filed on January 28, 2005) was filed on April 15, 2005 to request that

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the Examiner reconsider his decision not to enter the January 28th Amendment. Further, a Notice of Appeal was filed on February 16, 2005, and an Appeal Brief (which assumed entry of the April 15th Amendment) was filed on April 16, 2005;

4. That in response to the Appeal Brief and the Second After-final Amendment, the Examiner mailed a Notice of Non-Compliant Appeal Brief dated June 30, 2005, refusing (implicitly) to enter the Second After Final Amendment, and alleging that the Appeal Brief filed on April 16, 2005 was defective because the January 28, 2005 Amendment (and presumably the April 15, 2005 Amendment) was not entered.

6. That the January 28, 2005 Amendment (and likewise the April 15, 2005 Amendment) did not raise new issues and did not require further search by the Examiner, and therefore, should have been entered by the Examiner.

Specifically, Appellant notes that original claim 11 which was in the Application as filed on October 19, 1999 recited "*performing a tree-based collapsing of said personalized IVR dialogue menu*". The Examiner (or his predecessor) rejected claim 11 on at least seven (7) occasions (i.e., in Office Actions dated April 10, 2002, September 25, 2002, February 28, 2003, July 1, 2003, January 5, 2004, June 16, 2004 and November 16, 2004).

In the January 28, 2005 Amendment, claim 1 (and similarly in claims 16, 26 and 28) was amended to recite "*retrieving the caller profile to construct a personalized IVR dialogue menu by performing a tree-based collapsing and play out the personalized IVR dialogue menu via said telephone*".

Therefore, it is completely disingenuous for the Examiner, after having rejected claim 11

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at least 7 times, to now attempt to allege that the limitation of claim 11 added to claims 1, 16, 26 and 28 raises a new issue.

Indeed, for example, in the January 5, 2004 Office Action the Examiner stated that the limitation of claim 11 is **disclosed in Hanson** at col. 3, lines 47-48, and in the June 16, 2004 Office Action the Examiner stated that the limitation of claim 11 is **disclosed in Polcyn** at col. 6.

Therefore, it is completely unreasonable for the Examiner now to allege that this feature has not yet been considered by the Examiner.

7. Therefore, Appellant respectfully submits that the Amendment filed on January 28, 2005 (and likewise the Second After-Final Amendment filed on April 15, 2005), did not raise new issues and did not require further search by the Examiner, and therefore, should have been entered by the Examiner.

Therefore, Appellant respectfully requests the following:

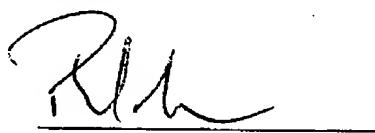
- a) that the Notice of Non-Compliant Appeal Brief be withdrawn,
- b) that the Amendment of January 28, 2005 (or the Second After-Final Amendment filed on April 15, 2005) be entered; and
- c) for an Examiner's Answer in response to the Appeal Brief filed on April 16, 2005.

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Please charge any deficiencies and/or credit any overpayments necessary to enter this paper to Attorney's Deposit Account number 50-0481.

Respectfully submitted,

Dated: 8/1/05



Phillip E. Miller
Reg. No. 46,060

McGinn & Gibb, PLLC
8321 Old Courthouse Road, Suite 200
Vienna, Virginia 22182-4100
(703)761-4100
Customer Number: 21254